

### REMARKS

Claims 1-23 are pending in the present application. Claims 1-23 stand rejected as of the office action mailed December 1, 2008. Claims 1-6, 9, 12, 13, 15, 16, and 22 have been amended, and claims 10, 11, 14, and 21 have been canceled. The Examiner is respectfully requested to reconsider and withdraw the rejections of record in view of the amendments and remarks contained herein.

#### Amendments to the Claims

Claim 1 as amended includes features recited in canceled claims 10, 11, and 14. No new matter was added. Claim 1 was also amended to recite "a tape configured to adhere" in the manner suggested by the Examiner to overcome 35 U.S.C. § 101 rejection.

Claim 16 as amended recites features found in canceled claims 10, 11, and 14. No new matter has been added.

Claims 2-6, 9, 12, 13, 15, and 22 have been amended to more particularly point out and distinctly claim that which the Applicants regard as their invention. No new matter has been added. Support can be found at least in the claims themselves. Support for "pressure roller" of claims 2, 3, and 5 can additionally be found in the specification at least at pages 4-5 (¶¶ 19-21, and 25 in the published application). Support for the amendment to claim 15 can additionally be found in the specification at least at page 7 (¶ 31 in the published application).

#### Claim Rejections – 35 USC §101

Claims 1-15 stand rejected under 35 USC § 101 because the Examiner asserts that original claim 1, which recited "a tape which adheres to the hairs ... where the hairs are plucked from the skin," was claiming the human body or portions thereof as part of the claimed subject matter. No such interpretation was intended, and Applicants respectfully disagree with such assertion. Nevertheless, claim 1 has been amended to recite the characteristics of the tape in the manner suggested by the Examiner, who indicated that such an amendment would overcome the

35 U.S.C. § 101 rejection of record. Accordingly, it is requested that the rejection of record be reconsidered and withdrawn.

*Claim Rejections – 35 USC § 102*

Claims 1-10, 12-13 and 15-23 stand rejected under 35 USC § 102(b) as being anticipated by U.S. Patent No. 2,423,245 to Magnus et al., (“Magnus”). This rejection is respectfully traversed.

Claim 1, as amended, requires “a drive motor configured to drive the take-up reel,” and “a switch in electrical communication with the drive motor and responsive to the application of the epilator apparatus against skin, such that application of the epilator apparatus against the skin activates the drive motor to drive the take-up reel,” and claim 16, as amended, requires “activating a drive motor, which drives a take-up reel, upon the application of the epilator apparatus to the skin.” The Examiner agrees that Magnus does not disclose either a drive motor, which drives the take-up reel, or that the drive motor is activated when the epilator apparatus is applied against the skin. OA, page 4, ¶¶ 11 & 12. It is therefore submitted that Magnus does not anticipate, at least, the above recited limitations of claims 1 and 16.

Claims 2-9, 12-13, 15, 17-20, 22-23 recite additional features in combination with those of base claims 1 and 16. As these dependent claims are not anticipated by the applied reference at least for the reasons discussed above with respect to claims 1 and 16, it is submitted that a thorough analysis of each of these claims is not necessary to the disposition of this case. This should not be misconstrued as an acquiescence to any particular conclusion or reference characterization.

*Claim Rejections – 35 USC § 103*

Claims 8, 11, and 14 stand rejected under 35 USC § 103(a) as being unpatentable over Magnus. This rejection is respectfully traversed.

The rejection is improper because the Examiner has not complied with the mandates of *Graham v. John Deere and Co.* 383 U.S. 1 (1966). The test for non-obvious subject matter is

whether the differences between the subject matter and the prior art are such that the claimed subject matter as a whole would have been obvious to a person having ordinary skill in the art to which the subject matter pertains. The United States Supreme Court in *Graham v. John Deere and Co.*, set forth the factual inquiries which must be considered in applying the statutory test: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; and (3) resolving the level of ordinary skill in the pertinent art.

With respect to the first factual inquiry under *Graham*, the Examiner asserts that Magnus represents the scope and content of the prior art. *See* OA, page 3-4. Then, the Examiner identifies, for the second factual inquiry, that the asserted art lacks, at least, a drive motor, which drives the take-up reel, and that the drive motor is activated when the epilator apparatus is applied against the skin. OA, page 4, ¶¶ 11 & 12. The Examiner asserts that it would have been obvious to provide the missing limitations without citing to any art supporting this assertion. OA, page 4, ¶¶ 11 & 12. Thus, with respect to these first two factual inquiries, the *prima facie* case fails to provide factual findings that these missing limitations are within the scope and content of the prior art. Moreover, the Examiner does not provide any findings that the missing limitations are within the level of ordinary skill in the art. "It is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." MPEP § 2144.03(A); *see In re Zurko*, 258 F.3d 1379, 1385 (Fed Cir. 2001) (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection).

In resolving the level of ordinary skill in the pertinent art, as required by the third step in *Graham*, the Examiner must step backward in time and into the shoes worn by a person of ordinary skill when the invention was unknown and just before it was made. The hypothetical person skilled in the art can summarily be described as one who thinks along lines of conventional wisdom in the art and as being neither one who undertakes to innovate nor one who

has the benefit of hindsight. *See Standard Oil Co. v. American Cyanamid Co.*, 227 U.S.P.Q. 293, 298 (Fed. Cir. 1985) and M.P.E.P. § 2145. Applicant asserts that if a person of ordinary skill in the art were to consult Magnus, that person would not find these features obvious.

Claim 1, as amended, requires the following features of canceled claims 11 and 14 - "a drive motor configured to drive the take-up reel," and "a switch in electrical communication with the drive motor and responsive to the application of the epilator apparatus against skin, such that application of the epilator apparatus against the skin activates the drive motor to drive the take-up reel," and claim 16, as amended, requires "activating a drive motor, which drives a take-up reel, upon the application of the epilator apparatus to the skin." It would be contrary to the disclosure of Magnus to modify Magnus to provide these missing features because Magnus teaches that his invention "comprehends a novel construction and arrangement in which any superfluous hairs are entrapped between two strips of adhesive tape on applying a requisite amount of gripping action and by a quick pull those hairs retained between the tapes are quickly and effectively removed," such that the "hairs are retained between the tapes and then as the operator pulls the device quickly in a manner similar to the operation of a pair of tweezers, [so that] those hairs are removed." Magnus, column 1, lines 11-17 and column 3, lines 47-51, respectively. The operation of Magnus' device is therefore based on first entrapping hairs between two strips of adhesive tape, and then quickly pulling on the device to extract the entrapped hairs. *See* Magnus, column 1, lines 11-17; column 3, lines 40-51; column 4, lines 70-17. Thus, the Examiner's proposed modification would change the principle of operation of the invention of Magnus, as it is not at all clear how the principle of first fixing the hairs to the tape, and then quickly pulling on the device to pluck the entrapped hairs (similar to the operation of tweezers) could be effectuated in the proposed modification of Magnus. *See* MPEP § 2141.01(VI) (reciting "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious.").

Moreover, the principle of operation of the invention of Magnus is contrary to the Examiner's asserted motivation to provide a drive motor (improved efficiency of the device), as

it would be inefficient to continually start and stop a drive motor in order to pluck the hairs out as required by the principle of operation of Magnus. Accordingly, it is submitted that claims 1 and 16 requiring features of canceled claims 11 and 14 are not obvious in view Magnus, nor are the claims depending therefrom, at least for the reasons discussed above.

### CONCLUSION

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reason for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to amendment. Applicant respectfully requests consideration of all filed IDS' not previously considered, by initialing and returning each Form 1449.

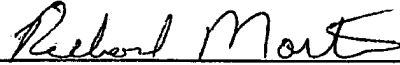
No charges are believed due. However, if any fees are due, they are being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any charges or credits to deposit account 06-1050, referencing Attorney Docket No. 02894-0750US1.

Applicant : Frieder Grieshaber et al  
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Page : 11 of 11

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Respectfully submitted,

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